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Docket No. K06-159566M/TBS

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REMARKS

Applicants concurrently file herewith a Petition for Extension of Time, and corresponding extension of time fee, for a one-month extension of time, to extend the period to respond to the Office Action dated January 6, 2005 to May 6, 2005.

Applicants concurrently file herewith an Excess Claim Fee Payment Letter, and corresponding excess claim fee, for one (1) excess independent claim.

Entry of this Amendment is believed proper since no new issues are being presented to the Examiner which would require further consideration and/or search.

Claims 1-5, 7, 8, 10-20, 22-24 and 27 are all of the claims presently pending in the application. Claims 1, 4, 6-8, 10-16, 18, 20, 22 and 23 have been amended to more particularly define the invention. Claims 6, 9, 21, 25 and 26 have been canceled without prejudice or disclaimer. Applicants reserve the right to file a Continuation Application directed to the subject matter of these canceled claims.

It is noted that the claim amendments are made only for more particularly pointing out the invention, and not for distinguishing the invention over the prior art, narrowing the claims or for any statutory requirements of patentability. Further, Applicants specifically state that no amendment to any claim herein should be construed as a disclaimer of any interest in or right to an equivalent of any element or feature of the amended claim.

Applicants gratefully acknowledge the Examiner's indication that claim 6, 8, 9 and 16-18 would be allowable if rewritten in independent form and that claims 24 and 27 are allowed. Claims 8 and 16 have been rewritten in independent form. However, Applicants respectfully submit that all of the claims are allowable.

Claims 1-5, 7, 10-15, 19-23, 25 and 26 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Scheurecker (U.S. Patent No. 4,007,822) and further in view of JP 10-2910590.

This rejection is respectfully traversed in the following discussion.

I. THE CLAIMED INVENTION

The claimed invention of exemplary claim 1 provides a roll apparatus provided at a continuous caster for transferring a cast piece to a predetermined location including at least

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three divided rolls arranged to align concentrically and in an axial direction thereof to constitute a roll forming a cast piece transfer path. At least one end portion of at least one of the divided rollers is supported by a cylindrical roller bearing of a full roller type, the cylindrical roller bearing includes an outer ring member, having a cylindrical outer diameter surface, an inner ring member, and a plurality of cylindrical rollers rollably arranged between the outer ring member and the inner ring member. The outer ring member is an integral one piece member including a surface contacting with the cylindrical roller and a cylindrical outer circumferential surface (e.g., see Application at page 5, line 23 through page 6, line 3). This feature is important for providing a roll apparatus having a high load capacity (see Application at page 2, lines 11-13).

II. THE PRIOR ART REFERENCES

The Examiner alleges that JP 10-2910590 would have been combined with Scheurecker to form the claimed invention of claims 1-5; 7, 10-15, 19-23, 25 and 26. Applicants submit, however, that these references would not have been combined and even if combined, the combination would not teach or suggest each and every element of the claimed invention.

That is, these references would not have been combined as alleged by the Examiner. Indeed, these references are directed to different problems and solutions.

Specifically, Scheurecker is directed to a strand guide having a relief means that is self-locking to prevent the strand parts from moving during unintended losses of pressure (see Scheurecker at column 1, lines 28-56), whereas JP 10-209105 is merely directed to preventing the development of flaking caused by thermal expansion of a roll (see JP 10-209105 at Abstract). Therefore, the problems being respectively addressed in these references are completely unrelated, and a person of ordinary skill in the art, attempting to improve Scheurecker, would have no reasonable motivation to consult the disparate reference JP 10-209105, absent impermissible hindsight.

Furthermore, the alleged motivation to modify Scheurecker (“in order to support loading in the axial direction and also prevent development of flaking”) does not appear to be a problem in Scheurecker that requires a solution. Therefore, as stated in MPEP 2143.01 the Examiner’s motivation is “improper”. “The mere fact that references can be combined or

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modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination” (emphasis in MPEP).

Therefore, Applicants respectfully submit that one of ordinary skill in the art would not have been so motivated to combine the references as alleged by the Examiner. Therefore, the Examiner has failed to make a prima facie case of obviousness.

Furthermore, neither Scheurecker nor JP 10-291059, nor any combination thereof, teaches or suggests a roll apparatus including a “*cylindrical roller bearing comprising: an outer ring member, having a cylindrical outer diameter surface; an inner ring member; and a plurality of cylindrical rollers rollably arranged between the outer ring member and the inner ring member, wherein the outer ring member comprises an integral one piece member comprising a surface contacting with said cylindrical roller and a cylindrical outer circumferential surface*” as recited in claim 1 and similarly recited in claim 10.

The novel features of the claimed invention are not taught or suggested by Scheurecker. The Examiner attempts to rely on Figure 1 of Scheurecker to support his allegations. The Examiner, however, is clearly incorrect.

Nowhere, however, in Figure 1 (nor anywhere else for that matter) does Scheurecker teach or suggest a roll apparatus provided at a continuous caster for transferring a cast piece to a predetermined location including a cylindrical roller bearing including an outer ring member, having a cylindrical outer diameter surface, an inner ring member, and a plurality of cylindrical rollers rollably arranged between the outer ring member and the inner ring member. The outer ring member includes an integral one piece member including a surface contacting with the cylindrical roller and a cylindrical outer circumferential surface. Indeed, Scheurecker merely depicts an upper supporting roller and a lower supporting roller having three divided pieces.

Moreover, the novel features of the claimed invention are not taught or suggested by JP 10-291059. The Examiner attempts to rely on JP 10-291059 as teaching a long and short roller supported by an independent cylindrical roller bearing on each roller.

A cylindrical roller bearing according to exemplary aspects of the claimed invention is of a full roller type. That is, a cage for retaining the roller is not provided. This feature is not disclosed in JP 10-291059.

Further, the outer ring member according to the claimed invention, of exemplary

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claim 1, is an integral one piece member including a surface contacting with the cylindrical rollers and a cylindrical outer circumferential surface. This feature is also not disclosed in JP 10-291059.

In Figure 1 of JP 10-291059, an outer ring includes a surface for contacting with rollers as well as a spherical outer surface, and a self-aligning ring, which includes a spherical inner surface and a cylindrical outer surface that is provided outside of the outer ring member.

Thus, JP 10-291059 fails to make-up for the deficiencies of Scheurecker.

Therefore, Applicants submit that these references, even if combined, would not teach or suggest each and every element of the claimed invention. Therefore, the Examiner is requested to withdraw this rejection.

III. FORMAL MATTERS AND CONCLUSION

In view of the foregoing, Applicant submits that claims 1-5, 7, 8, 10-20, 22-24 and 27, all of the claims presently pending in the application, are patentably distinct over the prior art of record and are in condition for allowance. The Examiner is respectfully requested to pass the above application to issue at the earliest possible time.


Should the Examiner find the application to be other than in condition for allowance, the Examiner is requested to contact the undersigned at the local telephone number listed below to discuss any other changes deemed necessary in a telephonic or personal interview.

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The Commissioner is hereby authorized to charge any deficiency in fees or to credit any overpayment in fees to Attorney's Deposit Account No. 50-0481.

Respectfully Submitted,

Date: May 6, 2005

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FACSIMILE TRANSMISSION

I hereby certify that I am filing this paper via facsimile, to Group Art Unit 1725, at (703) 872-9306, on May 6, 2005.

Respectfully Submitted,

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